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Filing date: **06/07/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92052388
Party	Defendant Sulzer Mixpac AG
Correspondence Address	SULZER MIXPAC AG RUTISTRASSE 7 HAAG (REINTAL), CH-9469 SWITZERLAND
Submission	Motion to Suspend for Civil Action
Filer's Name	Michael T. Murphy
Filer's e-mail	chicago.trademarks@klgates.com
Signature	/Michael T. Murphy/
Date	06/07/2010
Attachments	teal.PDF ( 8 pages )(170404 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 3762233

Filed: December 1, 2008

For the Mark: Teal Mixing Tip Configuration in International Classes 7, 8 and 10

Registered: March 23, 2010

Pac-Dent International, Inc.,

Petitioner,

v.

Sulzer Mixpac AG,

Registrant.

Cancellation No. 92052388

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**MOTION TO STAY THE CANCELLATION AND SUSPEND PROCEEDING PENDING  
OUTCOME OF CIVIL ACTION**

Registrant Sulzer Mixpac AG (“Sulzer” or “Registrant”), by its undersigned counsel, K&L Gates LLP, respectfully submits this reply to Petitioner’s Petition for Cancellation of Registrant’s mark.

In support of its reply, Registrant states as follows:

**I.  
INTRODUCTION**

Sulzer filed suit against Petitioner based upon trademark and patent infringement in the United States District Court Southern District of New York (“District Court”) in *Sulzer Mixpac USA, Inc. and Sulzer Mixpac AG vs. Pac-Dent International Inc., Pac-Dent, Inc., Pac-Dent International (Suzhou), Ltd. and Daniel Y. Wang*, No. 09-Civ 10430-(DAB) on March 18, 2010 (the “Civil Action”). A copy of an Order To Show Cause For Preliminary Injunction With

Temporary Restraining Order issued by the District Court preventing further sale of Defendant's products is enclosed as Exhibit A. The Temporary Restraining Order has been extended with the consent of Petitioner.

In response, Petitioner has filed a Cancellation against Registrant's Teal Mixing Tip, U.S. Reg. No. 3762233, with the Trademark Trial and Appeal Board ("Board"). Because the outcome of the Civil Action will have a bearing on the Cancellation, granting Registrant's Motion to Stay the Cancellation and suspension of the subject proceeding is appropriate.

## **II. ARGUMENT**

If it comes to the attention of the Board that a party or parties to a case pending before the Board are involved in a civil action that may have bearing on the Board case, the Board has the authority to suspend the proceeding until the final determination of the civil action. 37 CFR § 2.117; TMBP § 510.02(a). The rationale is that to the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is often binding on the Board, while the decision of the Board is not binding upon the court. TMBP § 510.02(a); *see e.g., Goya Foods Inc. v. Tropicana Products, Inc.*, 846 F.2d 848, 6 U.S.P.Q.2d 1950, 1954 (2d Cir. 2988).

Applicant and Petitioner are both parties to the Civil Action. The Civil Action will determine whether Petitioner's product is confusingly similar to, and infringes, Registrant's Teal Mixing Tip configuration mark. Accordingly, the rulings and findings in the Civil Action will have a bearing on, if not be dispositive of, the principal issues involved in this Cancellation proceeding. Registrant seeks to suspend this proceeding to avoid the unnecessary burden on the Board and the parties of litigating in multiple proceedings. As such, it is in the interest of


judicial economy that the Board suspend this proceeding until the final determination of the Civil Action.

**III.**  
**CONCLUSION**

WHEREFORE, Registrant respectfully requests that the Board suspend the above-captioned Cancellation proceeding pending disposition of the Civil Action.

Dated: June 7, 2010.

SULZER MIXPAC AG  
Registrant

By:   
One of Its Attorneys

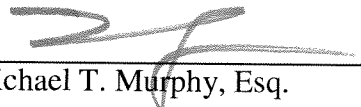
Michael T. Murphy, Esq.  
Christopher S. Adkins, Esq.  
K&L GATES LLP  
1601 K Street NW  
Washington, DC 20006-1600  
(312) 807-4272

**CERTIFICATE OF SERVICE**

The undersigned, an attorney, hereby certifies that he caused a copy of **SULZER MIXPAC AG'S MOTION TO STAY THE CANCELLATION AND SUSPEND PROCEEDING PENDING OUTCOME OF CIVIL ACTION** to be served upon:

Philip H. Gottfried  
Amster, Rothstein & Ebenstein LLP  
90 Park Avenue  
New York, NY 10016  
United States  
[ptodocket@arelaw.com](mailto:ptodocket@arelaw.com)

by first class mail, proper postage prepaid, this 2<sup>nd</sup> day of June, 2010.

  
\_\_\_\_\_  
Michael T. Murphy, Esq.

**EXHIBIT A**

USDC SDNY  
DOCUMENT  
ELECTRONICALLY FILED  
DOC #:  
DATE FILED: 3-19-10

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

-----X  
SULZER MIXPAC USA, INC. and SULZER  
MIXPAC AG,

Plaintiffs,

- against -

PAC-DENT INTERNATIONAL INC.,  
PAC-DENT, INC.,  
PAC-DENT INTERNATIONAL (SUZHOU), LTD.,  
DANIEL Y. WANG

Defendants.  
-----X

1:09-cv-10430-DAB

ORDER TO SHOW CAUSE  
FOR PRELIMINARY  
INJUNCTION WITH  
TEMPORARY RESTRAINING  
ORDER

Upon the declarations of Richard Wilson, Armin Hegglin and Stefan Kluthe sworn to the 16th day of March \_\_, 2010 and accompanying exhibits, and upon the copy of the amended complaint hereto annexed, it is

ORDERED that the above named Defendants show cause before The Honorable Deborah A. Batts, U.S.D.J. at Room 248, United States Courthouse, 500 Pearl Street, in the City, County and State of New York, on April \_\_, 2010, at 11:00 o'clock in the forenoon thereof, or as soon thereafter as counsel may be heard, why an order should not be issued pursuant to Rule 65 of the Federal Rules of Civil Procedure:

- a. Enjoining Defendants and each and every of them, and their representatives, servants, agents, employees, officers, directors, partners, attorneys, subsidiaries and all persons under their control or in active concert or participation with them, from selling, offering for sale, distributing or advertising dental mixing tips that

infringe the Mixpac Colored Dome Mark, or embody the Trade Dress of Mixpac's mixing tips including on the internet or any websites controlled by Defendants, or from passing off or otherwise representing to the public in any way that any mixing tip sold by them emanates from or is related in source or sponsorship or any other way to Mixpac.

- b. Ordering Defendants and all their representatives, agents, servants, employees, officers, directors, partners, attorneys, subsidiaries and all persons under its control or in active concert or participation with them, to preserve during the pendency of this action all copies of the infringing mixing tips or inventory and records relating thereto, and all advertising therefor;

and it is further

ORDERED that, sufficient reason having been shown therefor, pending the hearing of plaintiff's application for a preliminary injunction, pursuant to Rule 65, Fed. R. Civ. P., and 15 U.S.C. § 1116, the Defendants and each and every of them, and their representatives, servants, agents, employees, officers, directors, partners, attorneys, subsidiaries and all persons under its control or in active concert or participation with them are temporarily restrained from selling, offering for sale, distributing or advertising dental mixing tips that infringe the Mixpac Colored Dome Mark, or embody the Trade Dress of Mixpac's mixing tips including on the internet or any websites controlled by defendants; from passing off or otherwise representing to the public in any way that any mixing tip sold by them emanates from or is related in source or sponsorship or any other way to Mixpac.



ORDERED that Defendants shall preserve during the pendency of this action all copies of the infringing mixing tips or inventory in their possession or control, and all documents or records relating thereto and advertising therefore, and it is further

ORDERED that security in the amount of \$ 1,000.00 in cash to be deposited by wire transfer with the Clerk of the Court before March 24, 2010 at 4:00 o'clock in the fore noon of that day and that such security is found to be sufficient; and it is further

ORDERED that personal service of a copy of this order and annexed affidavits upon the Defendants or their attorneys on or before 4: o'clock in the after noon, of March 23, 2010 shall be deemed good and sufficient service thereof; and it is further

ORDERED that the defendants shall respond to all discovery demands served on them on the days demanded and not later than 8 days after issuance of this Order.

New York, New York  
March 19, 2010

Deborah A. Betts

United States District Judge